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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,165

Applicant(s)

MAK, JOON MUN

Examiner

Wen-Tai Lin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 30-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 45-56 and 59-74 is/are rejected.
- 7) ☒ Claim(s) 57 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/19/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-74 are presented for examination. Claims 1-29 and 45-74 are provisionally elected for examination in response to the previous restriction requirement.

2. In response to the previous restriction requirement Applicant argues: "Group II merely includes the combined functionality of Internet-based telephony used for both voice and fax." Therefore Applicant suggests that the examiner will not be required to make additional search in considering the inventions described in the restricted claims.

The examiner respectfully disagrees with Applicant's argument. Specifically, appropriate explanation has been given in the previous office action showing that group II is drawn to apparatus for establishing internet-based telephony with capability of automatic detection and switching for an incoming voice or facsimile messages. In other words, group II requires an otherwise nominal gateway server (which corresponds to the network node in the claim language) to detect and distinguish between voice and facsimile signals. Such subject matter in the context of telephony is covered in class 379, subclasses 900-905 as described in the previous office action. Thus although groups I and II are related inventions (i.e., related as sub-combinations of one another), they are nevertheless distinctive under the criteria of MPEP § 806.05(c) - § 806.05(i) (see MPEP 808.02).

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3. Claims 45-69 and 71-72 are objected to because the following terms lack antecedent basis:

In claim 45, "the appropriate communications channel"; and

In claim 58, "the public-switched telephone network".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 11-12, 16-20, 45-48, 50-56, 68-70 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Galvin et al.[U.S. Pat. No. 6351464].

6. As to claims 1, 16 and 18-20, Galvin teaches the invention as claimed including: an electronic communications system with at least one user, comprising:
a gatekeeper in electronic communication with a packet-switched communications network, wherein said gatekeeper is capable of associating a user's subscriber identifier with a dynamic Internet Protocol address for the user [22, Fig.1;

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col.5, lines 31-52; note further that the IP address assigned through an ISP is a temporary IP address (col.4, line 66- col.5, line 3)); and

a network node [28, Fig.1] in electronic communication with a circuit-switched communications network [14, Fig.1] and the gatekeeper [22, Fig.1], wherein said network node is capable of transmitting data over both the circuit-switched and the packet-switched network [col.6, lines 4-21].

7. As to claim 2, Galvin teaches that the system further comprising:

a subscriber database [24, Fig.1], wherein said subscriber database comprises data that matches at least one user's subscriber identifier with a dynamic Internet Protocol address for the user [col.5, line 53 – col.6, line 3].

8. As to claims 3-4, Galvin teaches that the system further comprising:

client software [19, Fig.1], wherein said client software is adapted to communicate with said gatekeeper over the packet-switched network [col.5, lines 31-41].

9. As to claim 5, Galvin further teaches that said client software comprises a graphical user interface adapted to allow a user to reject an incoming call [52, Fig.2; col.6, lines 59-65].

10. As to claim 11, Galvin teaches that the system further comprises a media server [col.6, lines 12-21].

11. As to claim 12, Galvin teaches that the system further comprises a message notification server [48, Fig.2; col.6, lines 53-56; i.e., the ACP itself is a message notification server].

12. As to claim 17, Galvin further teaches that said subscriber identifier is a telephone number that corresponds to the local dialing practices of the public switched telephone network [Abstract: lines 6-14].

13. As to claims 45-48, 50-56, 68-70 and 73, since the features of these claims can also be found in claims 1-5, 11-12 and 16-20, they are rejected for the same reasons set forth in the rejection of claims 1-5, 11-12 and 16-20 above.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin et al.(hereafter "Galvin") [U.S. Pat. No. 6351464], as applied to claims 1-5, 11-12, 16-20, 45-48, 50-56, 68-70 and 73 above, further in view of Official Notice.

16. As to claim 6, Galvin does not specifically teach that said client software comprises a graphical user interface including an auto-upgrade feature.

However, Official Notice is taken that providing auto-upgrading feature with a client software such as Internet browsing tools is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the auto-upgrading feature in Galvin's IP telephony agent because performing auto-upgrading via the Internet is fast and convenient, and it is a well-proven method for software upgrading.

17. As to claim 7, Galvin further teaches that when the called party rejects a call, the incoming message may be directed to a voice mail. Thus, although Galvin does not specifically teach that Galvin's graphical user interface includes an inbox to retrieve incoming messages, it is noted, however, that such an inbox for email or voice mail is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to keep the incoming voice mail inbox because an inbox store incoming messages and servers for later retrieval when the called party is available.

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18. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin et al.(hereafter "Galvin")[U.S. Pat. No. 6351464], as applied to claims 1-7, 11-12, 16-20, 45-48, 50-56, 68-70 and 73 above and Official Notice , as applied to claims 6-7 above, further in view of Chang et al.(hereafter "Chang")[U.S. PGPub 20030095542].

19. As to claim 8, Galvin teaches that when the called party rejects a call, the incoming message may be directed to a voice mail. Galvin does not specifically teach said inbox is adapted to allow a user automatically to call back a caller who is represented in said inbox, said user performing a single action to call back the caller.

However, in the same field of endeavor, Chang teaches a telephony system wherein a call log provides a log of outgoing calls and incoming calls with which users can make a return call by clicking any inbound call entry in the call log.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that when Galvin's called party review the voice mail stored in the inbox (e.g., a call log) the called party may decide to return a call by clicking on the associated mail because such a simplified activation process would facilitate the man-machine interface.

20. Claims 9-10, 13-15, 25-29, 49, 59-67, 71-72 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin et al.(hereafter "Galvin")[U.S. Pat. No. 6351464], as applied to claims 1-8, 11-12, 16-20, 45-48, 50-56, 68-70 and 73 above.

21. As to claims 9-10, Galvin teaches that a data network client may use an IP telephony client (i.e., a software) to receive voice packets over the Internet and for interfacing with the user. Galvin does not specifically teach that the software's user interface includes a do not disturb feature and an auto silence detection feature.

However, the "do not disturb" and "auto silence detection" are well-known features in a nominal smart telephone phone. The former is being used, e.g., when the called party is unavailable and the latter being used, e.g., to detect when a call is disconnected.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include these two features in Galvin's telephony agent because such features would help indicating to put a call on hold or ending a telephone session in an appropriate manner [col.6, lines 53-65; 54, Fig.2].

22. As to claims 13-15, Galvin does not specifically teach that the message notification server is adapted to notify a user that a facsimile message and a voice mail message or a missed call was received.

However, Galvin teaches that when a call is not accepted by a called party, the ACP may be instructed to continue with calling sequence according to a pre-registered calling profile or activate a voicemail.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Galvin's teaching of calling profile could have included notifying a user of voice mail message (when a call is being converted into a voice mail)

or notifying a user of facsimile message (when the calling profile indicates sending a facsimile message as an alternative) or notifying the user of a missed called in the continued calling sequence because such notification service would accommodate situations when a called party is not available for an intended call [42-44 and 52-54, Fig.2].

23. As to claims 25-27, Galvin teaches that the gatekeeper is a directory having an associated database for storing information regarding the calling profile of a client and whether the client is online or not. Galvin does not specifically teach that said gatekeeper is adapted to authenticate a user when said user logs into the system, places an outbound call, or when said user receives an incoming call.

However, it is well known in the art for authenticating a database user in particular when the content of database could be modified by the user or for security/priority reasons by restricting non-subscribers via authentication.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have authenticated Galvin's users when connecting to the gatekeeper for engaging the above activities because authentication is a practical way of identifying valid users.

24. As to claim 28, Galvin does not specifically teach that said gatekeeper is adapted to remove the association between the dynamic Internet Protocol address and the subscriber identifier of a user that has logged out of the packet-switched network.

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However, this is an obvious step in Galvin's system because it is well known that the IP address assigned to a user who connects to the Internet via ISP is valid only for the connection session and such a temporary IP address would be of no use for a next connection session.

25. As to claim 29, Galvin does not specifically teach that the rerouting includes placing the incoming call over the circuit-switched network to a traditional telephone number.

However, Galvin teaches defining calling profile for rerouting a call until the called party is reached, wherein such rerouting includes sending message into a voice mail [Abstract; col.2, lines 49-57; 54, Fig.2].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have rerouted the incoming call over the traditional telephone network because the latter is an obvious option to Galvin's voice mail as described above.

26. As to claims 49, 59-67, 71-72 and 74, since the features of these claims can also be found in claims 1-20, 25-29, 45-48, 50-58, 68-70 and 73, they are rejected for the same reasons set forth in the rejection of claims 1-20, 25-29, 45-48, 50-58, 68-70 and 73 above.

27. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galvin et al.(hereafter "Galvin")[U.S. Pat. No. 6351464], as applied to claims 1-20, 25-29, 45-56 and 59-74 above, further in view of Vaziri et al.(hereafter "Vaziri")[U.S. Pat. No. 6671272].

28. As to claims 21-24, Galvin does not specifically teach that said network node comprises call scripting functionality for defining user-definable voice messages, making voice mail announcement or user-definable call routing options.

However, Vaziri teaches that using scripting language for defining special logon procedure or making voice mail announcement is well known in the art and has been widely practiced in network dial-up environment [e.g., Vaziri: col.14, lines 57-63].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the call scripting functionality for defining the aforementioned messages because a called party is not logged on the data network and the use of scripting language enables Galvin's clients to define various customized voice messages (such as when a call is routed into a voice mail) and call routing options (similar to that is defined in the calling profile) [col.7, line 56 – col.8, lines 12] when the called party is not available.

29. Claims 57-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Dunn et al. [U.S. Pat. No. 6169795];

Joyce et al. [U.S. Pat. No. 6381316];

Eastep et al. [U.S. Pat. No. 6731625];

Voit et al. [U.S. Pat. No. 6295292];

Ma [U.S. Pat. No. 6373857]; and

Hagen [U.S. PGPub 20020075844].

31. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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January 19, 2005

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